UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,166	07/08/2000	Holger Kunstle	U-Wp-5528 Wacker	8687

22045 7590 09/18/2003

BROOKS & KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

EXAMINER	
AFTERGUT, JEFF H	
ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/612,166	KUNSTLE ET AL.	
	Examiner	Art Unit	
	Jeff H. Aftergut	1733	

--The MAILING DATE of this c mmunication appears n the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-19*.

Claim(s) withdrawn from consideration: _____.

8.☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

J. H. Aftergut

Jeff H. Aftergut
Primary Examiner
Art Unit: 1733

Continuation of 5. does NOT place the application in condition for allowance because: The applicant argues that the Japanese '705 reference desired a low tackiness and utilized the composition as a paint rather than an adhesive. The applciant equates the low tackines desired with a desire to employ a material with a high glass transition temperature. The applcaint is advised that the Example, example 1, of Japanese Patent '705 clearly suggested that one skilled in the art would have employed 15% VeoVa 10 (applciant in the response admitted that Vinyl neodecanoate was in fact VeoVa10). As such the reference clearly suggested in an example components a, b, and c of the claim. E.P. '727 in a similar composition suggested the inclusion of acrylic acid as a stabilizer in the amount of .2-3%thereby suggesting one skilled in the art would have included component d in the composition. the applciant is advised that a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).The applciant i therefore advised that while the reference to Japanese Patent '705 did not address the specified glass transition temperature, one skilled in the art would have readily appreciated that it met such requirements as the composition suggested by the combiantion was in fact the same as that claiemd by applciant. The applciant is additionally advised that the reference to E.P. '727 suggested that one skilled in the art would have incorporated the compositions not only as paints but also as adhesive compositions, page 3, lines 52-53. The applciant is advised regarding the postiion that the reference to E.P. '727 taught away for the combiantion that the reference was not being cted for th specified glass transition temperature or the specific VeoVa material employed but rather to express that those skilled in the art would have been expected to employ a stabilizer in a composition of Japanese Patent '705 as the compounds of E.P. '727 were similar in nature of Japanese Patent '705 and the use of a stabilizer would have improved the shelf life of the composition (for example). The applcaitn is additionally advised that the reference to Japanese Patent '182 was cited to evidence that the compounds expressed by E.P. '727 (who suggested that the material was useful as a paint or an adhesive) and Japanese Patent '705 (who suggested the compositon was useful as a paint) would have understood that the compounds wound have been suitable as an adhesive for flooring. It is agreed that the reference employed a solvent based adhesive, however as E.P. '727 expressed the materials woudla hve been useful as an adhesive without the solvents, one skilled in the art would have readily appreciated that the use of the material as a tile or flooring adhesive would have been within the purview of the ordianry artisan.